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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,348	11/17/2000	Erik D. Kokkonen	9837-009-999	6330

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Pennie & Edmonds, LLP
3300 Hillview Avenue
Palo Alto, CA 94304

EXAMINER	
LE, MIRANDA	

ART UNIT	PAPER NUMBER
2177	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/715,348	KOKLEONEN, ERIC	
	Examiner	Art Unit	
	Miranda Le	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. This communication is responsive to Amendment A, filed 07/15/2003.

2. Claims 1-36 are pending in this application. Claims 1, 7-8, 14-15, 21-22, 26, 29, 34-36 are independent claims. In the Amendment A, claims 32-36 have been added, and claims 1-2, 4, 7-11, 14-18, 21-22, 25-26, 28-29 have been amended. This action is made Final.

3. The objection to the specification of the invention has been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless:
>
> (e) the invention was described in
>
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
>
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 5-9, 12-16, 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagatomo et al. (US Patent No. 6,487,557 B1).

Nagatomo anticipated independent claims 1, 7, 8, 14, 15, 21 by the following:

As to claims 1, 8, 15, Nagatomo teaches "a method of generating directed content...receiving a set of lists from a plurality of remote web services, each list in said set of lists associated with a respective web service in a plurality of web services and each list in said set of lists including searches submitted to said respective web service" at col. 12, lines 32-46, col. 13, line 52 to col. 14, line 12, Fig. 6-Table 123;

"distilling said set of lists into a frequency database, the database storing search frequency information indicating, for respective searches, a frequency with respect to each of one or more of the plurality of remote web services to which the respective searches were submitted" at col. 16, line 1 to col. 17, line 12, Fig. 5-Table 122;

"obtaining a query" at col. 15, lines 36-38, col. 18, lines 21-31, Fig. 8;

"searching the frequency database for matches between said query and a search in the database" at col. 17, lines 29-66, Fig. 8;

"selecting the matches having highest associated frequencies, each selected match indicating a respective selected remote web service" at col. 18, lines 21-51, Fig. 8;

"generating directed content based on one or more of the selected web services" at col. 18, lines 21-61.

As to claims 7, 14, 21, Nagatomo teaches "a method of generating directed content...receiving a plurality of lists from a plurality of remote web services, each list in said plurality of lists associated with a respective web service in the plurality of remote web services and each list in said plurality of lists including searches submitted to said respective web service" at col. 12, lines 32-46, col. 13, line 52 to col. 14, line 12, Fig. 6-Table 123;

"distilling said plurality of lists into a frequency sorted list, the frequency sorted list including a plurality of entries, each entry having a search and a number of times said search was submitted to a respective web service" at col. 16, line 1 to col. 17, line 12, Fig. 5-Table 122;

"obtaining a query" at col. 15, lines 36-38, col. 18, lines 21-31, Fig. 8;

"searching the frequency sorted list for matches between said query and a search in the frequency sorted list' at col. 17, lines 29-66, Fig. 8;

"selecting the matches having highest associated frequencies, each selected match indicting a respective selected remote web service of the web services" at col. 18, lines 21-51, Fig. 8;

"generating directed content based on one or more of the selected remote web services" at col. 18, lines 21-61.

As to claims 2, 9, 16, Nagatomo teaches "directed content is a link to a web service that was selected during said searching step" at col. 14, lines 33-44, Fig. 8.

As to claims 5, 12, 19, Nagatomo teaches "a match having highest associated frequency is determined by a rank of a search, which matches said query, in a list associated with a web service in said plurality of web services" at col. 17, lines 29-67.

As to claims 6, 13, 20, Nagatomo teaches "a match having highest associated frequency is determined by a score that is a function of (i) a rank of a search, which matches said query, in a list associated with a web service in said plurality of web

services and (ii) the logarithm of the frequency of said search in the list" at col. 17, lines 29-67.

6. Claims 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Alberts et al. (US Patent No. 5,937,392).

As to claims 34, 35, 36, Nagatomo teaches "a method of generating a directed advertisement, the method comprising: obtaining a query" at col. 3, lines 1-18;

"selecting a remote web service based on said query" at col. 3, lines 1-18, col. 3, lines 26-54, col. 4, lines 1-62;

"routing said query to an instance of said selected remote web service; collecting data generated by said selected remote web service in response to said query" at col. 4, lines 1-62;

"generating said directed advertisement, said directed advertisement including a portion of said response in said advertisement" at col. 4, lines 1-62, col. 5, lines 7-49.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3-4, 10-11, 17-18, 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatomo et al. (US Patent No. 6,487,557 B1), in view of Alberts et al. (US Patent No. 5,937,392).

As to claims 22, 26, 29, Nagatomo teaches "a method of generating a directed advertisement...obtaining a query" at col. 15, lines 36-38;

"searching a web resource for a match between said query and an element of said web resource" at col. 16, lines 1-62;

"selecting a web service based on said element of said web resource" at col. 18, lines 21-61, Fig. 8;

Nagatomo does not specifically teach the following limitations. However, Alberts teaches:

"routing said query to an instance of said selected web service" at col. 2, line 55 to col. 3, line 17, col. 4, lines 1-62;

"collecting a response generated by said selected web service" at col. 4, lines 4-46, col. 4, line 50 to col. 5, line 18;

"generating said directed advertisement, said directed advertisement including a portion of said response in said advertisement" at col. 4, line 50 to col. 5, line 18.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Nagatomo with the teachings of Alberts to include "routing said query to an instance of said selected web service; collecting a response generated by said selected web service; generating said directed advertisement, said directed advertisement including a portion of said response in said advertisement" in order to provide an integrated system that allows ad to be served in a highly flexible and accurate manner a desired number of time throughout the day and evenly distributed or intensified at times if desired.

As to claims 3, 10, 17, Nagatomo teaches "identifying a category that corresponds to a selected web service" see Fig. 6;

Nagatomo does not explicitly teach "said directed content including an advertisement that corresponds to said category". However, Alberts teaches this limitation at col.2, lines 55-67.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Nagatomo with the teachings of Alberts to include "said directed content including an advertisement that corresponds to said category" in order to provide an integrated system that allows ad to be served in a highly flexible and accurate manner a desired number of time throughout the day and evenly distributed or intensified at times if desired.

As to claims 4, 11, 18, Nagatomo does not expressly teach the following limitations. However, Alberts teaches "routing said query to an instance of a selected remote web service" at col. 2, line 55 to col. 3, line 17, col. 4, lines 4-46, col. 4, line 50 to col. 5, line 18.

"collecting data generated by said selected remote web service in response to said query; wherein said advertisement includes a portion of said response" col. 4, lines 4-46, col. 4, line 50 to col. 5, line 18.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Nagatomo with the teachings of Alberts to include "routing said query to an instance of a selected remote web service; collecting data generated by said selected remote web service in response to said query; wherein said advertisement includes a portion of said response" in order to provide an integrated system that allows ad to be served in a highly flexible and accurate manner a desired number of time throughout the day and evenly distributed or intensified at times if desired.

As to claims 23, 27, 30, Nagatomo teaches "element of said web resource is a category" at col. 13, line 52 to col. 14, line 32, col. 18, lines 1-3, Fig. 6.

Alberts teaches this limitation at col. 3, lines 1-67.

As to claims 25, 28, 31, Nagatomo teaches "said web resource is a frequency database, the database storing search frequency information indicating, for respective

searches, a frequency with respect to each of one or more of a plurality of web services" at col. 17, lines 29-67, col. 18, lines 22-53;

"said element of said resource is an entry in the frequency database corresponding to said selected web service, said search frequency information stored in said frequency database indicating that said search has been conducted at said selected web service at a high frequency relative to other web services of said plurality of web services" at col. 14, lines 33-46, col. 12, lines 32-63, col. 17, lines 29-67, col. 18, lines 22-61.

9. Claims 24, 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatomo et al. (US Patent No. 6,487,557 B1), in view of Alberts et al. (US Patent No. 5,937,392), and further in view of Chris Sherman ("Google Introduces Web Directory Using Netscape's Open Directory Project Data").

As to claims 24, 32, 33, Nagatomo and Alberts do not specifically teach "the web resource is Open Directory Project". However, Sherman teaches this limitation on page 1-2.

It would have been obvious to one ordinary skilled in the art at the time of the invention was made to combine the teachings of Nagatomo, Alberts with the teaching of Sherman to include "the web resource is Open Directory Project" in order to creates the most comprehensive and robust search resource for finding information and browsing the web.

Response to Arguments

10. Applicant's arguments regarding Peercy reference does not teach the receipt of lists from remote web services, a sort list organized by searches; and Getchius does not teach routing a query to and receiving a response from a remote web service, including in a directed advertisement apportion of a response generated by a remote web service upon presentation of a query, with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (703) 305-3203.

The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703) 305-9790. The fax number to this Art Unit is (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Miranda Le
September 24, 2003

GRETA ROBINSON
PRIMARY EXAMINER